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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,063	04/16/2001	Focke Rass	225/49847	3891

7590 08/28/2003

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3677

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/835,063Applicant(s)
RassExaminer
EstremskyArt Unit
3677

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Aug 11, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
arguments not persuasive - see attached Supplement to the Advisory Action

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

ESTREMSKY
PRIMARY EXAMINER
ART UNIT 3677

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Supplement to the Advisory Action

1. Applicant's arguments have been considered but are not persuasive. As well settled in case law, it is the claims which define the scope of protection and therefore the invention. It is the examiner's position that the *product* claims of the Application for which Applicant now seeks exclusive rights to, have not patentably distinguished from well known structure of the prior art products from the same field of endeavor.

The examiner first notes that limitations for rough and fine positioning guide elements cannot be given weight in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185. Applicant's arguments hinge on a functional capability of the elements within context of some intended use. However, the claims do not define any structure that is not taught by the references, as applied. See MPEP 2114. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim

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are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

The examiner's position is that the prior art teaches all structures explicitly claimed and that the structures of the prior art are inherently capable of the recited function given their geometry. But in general, the similarity of the prior art structure with the presently *disclosed* structure should be noted. What *disclosed* structure is different from the prior art, and if there is a structural difference; has that structure been clearly defined *in the claim*.

Applicant argues that the Roethel patent has no 'explicit discussion' of 'guide play' but does not address explicit illustration of tolerance or 'guide play' in Fig's 2-4 of the reference for example. One of ordinary skill in the art would readily recognize that the illustrated tolerance unavoidably and inherently provides for some measure of movement (an "amount" generally equal to the illustrated tolerance). Further functional recitation related to the guide play has not patentably distinguished from the structure of the reference which is inherently capable of same. The claims have not described a range of tolerance or physical arrangement of the tolerance that can be relied upon for patentable distinction from the tolerance illustrated by the prior art.

Whether or not it is true, argument that the modifying reference 'is not a *fork-type* rotary latch' has little relevance to current issues in prosecution where the claim does not include the argued limitation, and the argument is improperly attacking the reference individually since it is a combination of prior art structures that has been relied upon in grounds of rejection. To a large

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extent, the issues discussed in the Request for Reconsideration have been more fully addressed in previous Office Actions and Applicant's attention is directed thereto for more complete explanation of the grounds of rejection and citations of relevant case law relied upon in interpretation and treatment of the claims.

While there may or may not be structural differences between Applicant's *disclosed* invention and the prior art, since the present *product* claims have not defined any particular structure that can be relied upon for patentable distinction from the similar and well known prior art products, withdrawal of present grounds of rejection is not proper.

Conclusion

2. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which

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applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

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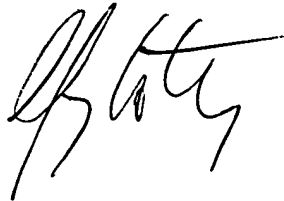
4. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

August 26, 2003

A handwritten signature in black ink, appearing to read 'G. Estremsky', with a stylized, cursive script.

GARY ESTREMSKY
PRIMARY EXAMINER